The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GERALD FRANCIS MCBREARTY, SHAWN PATRICK MULLEN, and JOHNNY MENG-HAN SHIEH

Appeal No. 2007-0731
Application No. 09/899,454
Technology Center 2100

Decided: April 24, 2007

Before ANITA PELLMAN GROSS, STUART S. LEVY, and ROBERT E. NAPPI *Administrative Patent Judges*.

NAPPI, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 of the final rejection of claims 1 through 36. For the reasons stated *infra* we affirm the Examiner's rejection of these claims.

INVENTION

The invention is directed to a method of presenting bookmarks with a web browser. The system provides information relating to the activity rate of a particular bookmarked web site when the user views their bookmarks. This way the user can choose to access the web site at a different time if there is significant activity. See page 3 of Appellants' Specification. Claim 1 is representative of the invention and reproduced below:

> 1. In a World Wide Web (Web) communication network with user access via a plurality of data processor controlled interactive receiving display stations for displaying received hypertext documents of at least one display page containing text and images transmitted from sources on the Web, a system for bookmarking of selected received Web documents comprising:
>
> means associated with one of said receiving display stations for bookmarking of selected received Web documents to thereby store at said receiving display station, direct links to the sources of said Web documents;
>
> means for tracking the rates of said bookmarked Web documents transmitted from each of said sources during daily time cycles; and
>
> means at said receiving display station for displaying in association with a displayed list of bookmarks for Web documents, data on the rates of transmission of said bookmarked documents at the time of said display.

REFERENCES

The references relied upon by the Examiner are:

Burke	US 6,032,162	Feb. 29, 2000
Pitkow	US 2002/0016786 A1	Feb. 7, 2002 (filed Dec. 4, 2000)
Ryan	U.S. 6,421,675 B1	Jul. 16, 2002 (filed Jul. 15, 1998)

Additional reference relied upon by the Board of Patent Appeals and Interferences

Pitkow	US 7,031,961 B2	Apr. 18, 2006 (filed Dec. 4, 2000)

REJECTION AT ISSUE

Claims 1 through 6, 8 through 18, 20 through 30, and 32 through 36 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Ryan and Pitkow. The Examiner's rejection is set forth on pages 3 through 9 of the Answer. Claims 7, 19, and 31 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Ryan, Pitkow, and Burke. The Examiner's rejection is set forth on page 10 of the Answer. Throughout the opinion we make reference to the Brief and Reply Brief (filed March 28, 2006 and August 14, 2006 respectively), and the Answer (mailed June 14, 2006) for the respective details thereof.

ISSUES

Appellants contend that the Examiner's rejection based upon Ryan and Pitkow under 35 U.S.C. § 103(a) is in error. Specifically, Appellants argue that Ryan teaches use of tracking transmission rates only in the context of search engine algorithms. Appellants further argue that there is no suggestion in Ryan to display the transmission rates of bookmarked documents at a receiving station. (Br. 7, Reply Br. 2-3). Appellants assert that Pitkow does not make up for this deficiency. (Br. 8).

The Examiner contends that the rejection is proper. The Examiner states that Ryan's "Personal hit-lists" suggests using Ryan's system with bookmarks, and that Pitkow teaches using bookmarks at a web page receiving station. The

Examiner therefore asserts that it would have been obvious to combine the references to arrive at the invention.

The Appellants' contention presents us with the issue of whether Pitkow and Ryan provide sufficient evidence to show that it would have been obvious to a skilled artisan to display with a list of bookmarks, data rates of transmission of said bookmarked documents.

FINDINGS OF FACT

Pitkow teaches a system for storing and organizing bookmarks. (Para. 0049). The drawings in the Pitkow Patent Application Publication (US 2002/0016786) are clearly not related to the disclosure of the publication and are not the drawings filed with that application. The Pitkow Patent (US 7,031,961) contains the drawings discussed in and filed with Pitkow's patent application. Accordingly, our discussion of Pitkow's drawings is drawn to the drawings in the Pitkow Patent.

Pitkow teaches a system where bookmarks for a group of users are stored in a bookmark database. (Para. 0050) By storing the bookmarks on a central server the system allows for additional information concerning the bookmarks to be presented such as whether the bookmarked page is available, is popular, or has been recently updated. (Para. 0053). This information is presented alongside the bookmark; see for figure 2, the icon, 228, in column 222, identifies that the bookmarked web page is unavailable, the icon, 230, in column 224, identifies that the bookmarked web page contains new content, and the icon, 232, in column 226, identifies that the bookmark is popular. (Para. 0053-0055) Pitkow teaches that popularity of the bookmark can be determined based upon how many other users have the same bookmark or that other means of determining popularity may be used such as frequency of use. (Para. 0055, 0086, 0097). Though Pitkow's system primarily uses a bookmark server to store the bookmarks, Pitkow also teaches that

the bookmarks may be maintained on both a server and the user's local machine and used in conjunction with a web browser. (Para. 0076, 0077). The user's local machine queries the bookmark server when a user session begins to obtain the information about the bookmarks. The user's machine also notifies the bookmark server if the user has made any changes to the list of bookmarks. Pitkow also teaches that the bookmark server may be used in providing web searches. (Para. 0103).

Ryan teaches a search engine for the internet. The system considers several factors in determining whether a web site meets the users search criteria. One of the measures is a measure of popularity based upon the number of times a web site is visited. Number of times accessed is referred to as number of hits value "x," see column 11, line 56 through column 12, line 31, tables 2 and 3, popularity in general is also discussed in col. 20-23. Ryan also teaches that results from a search may be saved in a manner similar to bookmarking. See column 20, lines 46-53 and column 23, lines 20-32.

PRINCIPLES OF LAW

As was recently described in *In re Kahn*, 441 F.3d 977, 78 USPQ2d 1329 (Fed. Cir. 2006):

> [T]he "motivation-suggestion-teaching" test asks not merely what the references disclose, but whether a person of ordinary skill in the art, possessed with the understandings and knowledge reflected in the prior art, and motivated by the general problem facing the inventor, would have been led to make the combination recited in the claims. From this it may be determined whether the overall disclosures, teachings, and suggestions of the prior art, and the level of skill in the art – i.e., the understandings and knowledge of persons

> having ordinary skill in the art at the time of the invention-support the legal conclusion of obviousness. (internal citations omitted).

Id. at 988, 78 USPQ2d at 1337. To establish a prima facie case of obviousness, the references being combined do not need to explicitly suggest combining their teachings. *See id.* at 987-88, 78 USPQ2d at 1337-38 ("the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references"). "'The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art.'" *Id.* at 987-88, 78 USPQ2d at 1336 (quoting *In re Kotzab,* 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000)).

ANALYSIS

Claim 1 recites "means for tracking the rates of said bookmarked Web documents transmitted from each of said sources ... displaying in association with a displayed list of bookmarks for Web documents, data on rates of transmission of said bookmarked documents." Independent claims 13 and 25 recite similar limitations. As mentioned above Pitkow teaches displaying at the user's machine, a list of bookmarks along with an indication of popularity. Pitkow does not determine the popularity based upon transmission rates of the web document from the source. Appellants admit, on page 7 of the Brief, that Ryan teaches tracking transmission rates of web documents at the source. Further, as discussed *supra,* Ryan teaches that tracking transmission rates is used in determining popularity. Given these two documents we find that one skilled in the art would have been led to the claimed invention of tracking web transmission of a document at the source to determine popularity and display the popularity along with the bookmark. Thus,

contrary to Appellants' arguments, we find ample evidence to support the Examiner's finding that the combination of Ryan and Pitkow teach the claimed invention, and we sustain the Examiner's rejection of independent claims 1, 13, and 25.

Appellants provide a separate argument directed to dependent claims 3 through 6, 15 through 18, and 27 through 30. In this argument Appellants concede that Ryan teaches the various techniques for determining activity for web sites and argue that Ryan does not teach applying these techniques to bookmarks (Br. 8). As discussed above we find ample evidence to suggest applying Ryan's methods of tracking popularity of a web site into bookmarks. Thus, Appellants' arguments have not convinced us of error in the Examiner's rejection of claims 3 through 6, 15 through 18, and 27 through 30. Accordingly, we sustain the Examiner's rejection of claims 3 through 6, 15 through 18, and 27 through 30.

Appellants provide a separate argument directed to dependent claims 9 through 12, 21 through 24, and 33 through 36. In these arguments Appellants assert that the claims are directed to web browsers associated with reviewing stations whereas Ryan is concerned with search engines which typically perform a different function. As such Appellants reason that Ryan is inapplicable to the claimed invention. (Br. 9). As discussed above Pitkow teaches a system of managing bookmarks that can be on the users' local machine, which is used in conjunction with a web browser. Further, as discussed above we find ample evidence to suggest applying Ryan's methods of tracking popularity of a web site into bookmarks. Thus, Appellants' arguments have not convinced us of error in the Examiner's rejection of claims 9 through 12, 21 through 24, and 33 through 36. Accordingly, we sustain the Examiner's rejection of claims 9 through 12, 21 through 24, and 33 through 36.

Appellants have presented no separate arguments directed to dependent claims 2, 8, 13, 14, 20, 25, 28, and 32. Accordingly we affirm these claims for the reasons discussed with respect to independent claims 1, 13, and 25.

On pages 9 and 10 of the Brief, Appellants argue that the rejection of claims 7, 19, and 31 under 35 U.S.C. § 103(a) as unpatentable over Ryan, Pitkow, and Burke is in error for the same reasons given with respect to the base claims. As Appellants' arguments have not convinced us of error in the Examiner's rejection of claims 6, 18, and 30 (the claims upon which claims 7, 19, and 31 depend) we are similarly not persuaded of error in the Examiner's rejection of claims 7, 19, and 31.

CONCLUSION

Appellants' arguments have not persuaded us of error in the Examiner's rejections of claims 1 through 36 under 35 U.S.C. § 103(a). Accordingly, we sustain these rejections. The decision of the Examiner is affirmed. We designate our affirmance of the Examiner's rejection as new grounds of rejection under 37 CFR § 41.50(b), as our rationale differs slightly from that expressed by the Examiner and because the figures of Pitkow which we rely upon were not made available to Appellants prior to our decision.

This decision contains a new ground of rejection pursuant to 37 CFR § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 CFR § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 CFR § 41.50(b) also provides that the Appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

> (1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .
>
> (2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

AFFIRMED
37 CFR § 41.50(b)

vsh

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